

REMARKS

Reconsideration and allowance of the present application are respectfully requested. Claims 1-20 are pending in this application. Claim 1 is an independent claim. Claims 1, 7 and 16-20 are amended. No new matter has been added.

Priority

Applicants note that the present action does not indicate that the certified copies of the priority documents have been received. Applicant respectfully requests that the Examiner's next communication include an indication as to whether the certified copies have been received so that Applicants may have a full and fair opportunity to respond.

Drawings

The drawing filed on August 16, 2006 has been accepted.

Information Disclosure Statement

Applicants appreciate the Examiner's consideration of the references cited in the Information Disclosure Statement filed on August 16, 2006.

Rejections under 35 U.S.C. § 101

Claims 1-20 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

The CAFC in *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008), stated that "[a] claimed process is surely patent-eligible under § 101 if:

- (1) it is tied to a particular machine or apparatus, or
- (2) it transforms a particular article into a different state or thing.

Bilski at 1391.

To the case at hand.

Claim 1

Claim 1 recites:

A method for determining a degree of compliance with a performance specification assigned to a medical working practice, the method comprising:

 recording and storing, by a data-processing device, data correlated with the medical working practice;

 storing, by a test system, test criteria for the data, correlated with the performance specification;

 reading, via the test system, the data stored in the data-processing device; and

 evaluating, via the test system, the data with the aid of the test criteria and determining the degree of compliance with the performance specification.

As the Examiner will appreciate, claim 1 is indeed tied to a particular machine or apparatus namely a "data-processing device" and a "test system." Therefore, the method of claim 1 is statutory subject matter eligible.

Having established that the method of claim 1 is statutory subject matter eligible, the Examiner must determine if the claimed invention falls within a judicial exception (law of nature, natural phenomena, or abstract idea). Claim 1 does not fall within a judicial exception.

Because claim 1 is tied to a particular machine or apparatus and does not fall within a judicial exception, claim 1 is a statutory process under 35 U.S.C. § 101. Claims 2-20 are statutory at least by virtue of their dependency from claim 1.

Rejection under 35 U.S.C. § 102

Claims 1-7 and 10-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated Sabol et al. (US 2004/0122719), hereinafter "Sabol." This rejection is respectfully traversed.

Claim 1 requires, *inter alia*, evaluating “data with the aid of the test criteria and determining the degree of compliance with the performance specification.” At least this feature is not disclosed or suggested by Sabol.

Sabol discloses a medical resource processing system. The system may provide material to a patient such as “structured video and/or audio recordings of questions and answers.” Paragraph [0332] of Sabol. The material provided is for the patient. Resources that can be processed include reference sources which represent information about “medical events, medical conditions, disease state,” and financial information. Paragraph [0052] of Sabol.

The Examiner relies on paragraph [0332] to teach the “evaluating” of claim 1. However, Sabol does not describe any evaluation of data on a test system with the aid of test criteria correlated with performance specification.

More specifically, Sabol makes reference to a “validation or data management system” to “control access to and quality of data within the local knowledge base.” Paragraph [0352] of Sabol. The criteria disclosed for the validation are “time of entry” and “source of data.”

As such, the validation or data management system of Sabol fails to determine a degree of compliance with performance specification. Therefore, Sabol fails to disclose or suggest the evaluating “data with the aid of the test criteria and determining the degree of compliance with the performance specification,” as set forth in claim 1.

Claims 2-7 and 10-20 are patentable at least by virtue of their dependency on claim 1.

For at least the foregoing reasons, Applicants request that the Examiner withdraw the rejection of claims 1-7 and 10-20 under 35 U.S.C. § 102.

Rejection under 35 U.S.C. § 103

Claims 8-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sabol in view of Miller et al. (US 5,446,653), hereinafter "Miller." This rejection is respectfully traversed.

The Examiner correctly acknowledges that the features of claims 8-9 are not disclosed or suggested by Sabol. However, the Examiner alleges that these features are taught by Miller. Even if Miller taught the features of claims 8-9 (which Applicants do not admit) and that Miller could be properly combined with Sabol (which Applicants do not admit), Miller fails to cure the deficiencies of Sabol as described above with reference to claim 1. Therefore, Sabol and Miller fail to render claims 8-9 obvious.

For at least the foregoing reasons, Applicants respectfully request that the Examiner withdraw the rejection of claims 8-9 under 35 U.S.C. § 103.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 1-20 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. §1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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